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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,032	07/07/2003	Kazunobu Kimura	61282-031	9382
7590 08/22/2008 McDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096				
EXAMINER				
FELTEN, DANIEL S				
ART UNIT		PAPER NUMBER		
3696				
MAIL DATE		DELIVERY MODE		
08/22/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,032

Applicant(s)

KIMURA, KAZUNOBU

Examiner

DANIEL S. FELTEN

Art Unit

3696

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 8 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Receipt of the amendment filed May 27, 2008 cancelling claims 3 and 8 are acknowledged. Claims 1, 2 and 4 are presented to examined upon their merits.

Response to Arguments

2. Applicant's arguments filed May 27, 2008 have been fully considered but they are not persuasive. The applicant has traversed the rejection using Bahr because, as the applicant asserts, that Bahri fails to disclose to suggest a proxy fee settlement system characterized in that "*an advertisement distribution contract* signed by a financial institution or service agent and partner is a contract per operation terminal such as an automatic teller machine in the advertisement request area, a collective contract signed by a plurality of stores in a shopping district, and a local area contract signed by a plurality of stores in a shopping district, and a local area contract tailored to the installation areas of operation terminals such as automatic teller machines."

It is respectfully submitted to the applicant that the aforementioned limitation is being interpreted by the Examiner as non-functional descriptive material. "said...contract" (or types of contracts) are considered an enumeration of abstract ideas, that represent a legally binding agreement between parties that present no requisite functionality to satisfy the practical application requirement. (see MPEP 2106.01). Thus the aforementioned limitation does not provide the requisite functionality that "said...contract" would cause the terminal (e.g, ATMs) to perform. Thus the rejection(s) using Bahri is being maintained.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahri et al (WO 01/67365)

Re claim 1: Bahri discloses a proxy fee settlement system characterized in that said proxy fee settlement system comprises advertisement distribution/proxy settlement contract management means for managing an advertisement distribution/proxy settlement contract signed by a financial institution or a service agent and a partner performing advertisement distribution at said financial institution or service agent, net banking site/automatic teller machine management means for managing online services for the net banking site or automatic teller machine at said financial institution or service agent, proxy settlement determination management means for determining a proxy settlement with a customer at said partner distributing an advertisement recognized by a customer in said online services, and Account management means for charging a fee for a financial procedure followed by a customer using said online services through the net banking site/automatic teller machine management means to the partner's account in accordance with the determination result of said proxy settlement *said advertisement distribution contract*

signed by said financial institution or service agent and said partner is a contract per operation terminal such as an automatic teller machine in an advertisement distribution request area, a collective contract signed by a plurality of stores in a shopping district, and a local area contract tailored to the installation areas of operation terminals such as automatic teller machines.

[see Abstract, page 1, line 5 to page 6, line 2, (especially page 4, line 9 to page 5, line 30), page 24, line 6 to page 26, line 31].

Re claim 2: characterized in that said proxy settlement contract is executed when a customer, having confirmed that a proxy fee settlement Service is available before said fee is charged, inputs financial procedure information on said net banking site or automatic teller machine[see Abstract, page 1, line 5 to page 6, line 2, (especially page 4, line 9 to page 5, line 30), page 24, line 6 to page 26, line 31].

Re claim 4: A proxy fee settlement system according to claim i, characterized in that said partner arbitrarily determines limiting conditions for proxy fee settlement under predetermined limitations specified by said financial institution and manages the limiting conditions on said advertisement distribution/proxy settlement contract management means in a proxy settlement contract signed by said financial institution or service agent, said partner and said customer. [see Abstract, page 1, line 5 to page 6, line 2, (especially page 4, line 9 to page 5, line 30), page 24, line 6 to page 26, line 31].

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL S. FELTEN whose telephone number is (571)272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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